



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/516,452

12/03/2004

Tetsuya Ishii

Q72632

2866

23373 7590 02/26/2009  
SUGHRUE MION, PLLC  
2100 PENNSYLVANIA AVENUE, N.W.  
SUITE 800  
WASHINGTON, DC 20037

EXAMINER

HOLLOMAN, NANNETTE

ART UNIT

PAPER NUMBER

1612

MAIL DATE

DELIVERY MODE

02/26/2009

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/516,452	<b>Applicant(s)</b> ISHII, TETSUYA	
	<b>Examiner</b> NANNETTE HOLLOMAN	<b>Art Unit</b> 1612	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 17 November 2008.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) 9-13 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

This Office Action is in response to the Request for Continued Examination filed on November 17, 2008. All previous rejections have been withdrawn unless stated below.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office Action.

Claims 1-8 have been examined.

#### ***Improper Hybrid Claim***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claim 8 is rejected under 35 U.S.C. 101 because the claimed invention is drawn to non-statutory subject matter.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 8 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

A single claim which recites both a product and method steps of using that product is indefinite under 35 USC 112, second paragraph. See Ex parte Lyell, 17 USPQ2d 1548 (Bd. Pat. App. & Inter. 1990). Such claims should also be rejected under 35 USC 101 on the theory that the claim is directed to neither a “process” nor a “machine”, but rather embraces or overlaps two different statutory categories of invention set forth under that statute, which is drafted so as to set forth the statutory classes of invention in the alternative only. Id. At 1551.

Instant claim 8 recites both a product (hydrous gel) and a process (forming into a film) as reflected in the phrase “formed”. Claim 8 is thus rejected (along with its dependent claims) as follows on the theory that the claim is directed to neither a “process” nor a product” exclusively.

***Claim Rejections - 35 USC § 112***  
***1<sup>st</sup> Paragraph***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-8 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The description requirement of the patent statute requires a description of an

Art Unit: 1612

invention, not an indication of a result that one might achieve if one made that invention. See, e.g., In re Wilder, 22 USPQ 369, 372-3 (Fed. Cir. 1984). (Holding that a claim was not adequately described because the specification did 'little more than outline goals appellants hope the claimed invention achieves and the problems the invention will hopefully ameliorate.')

Mere indistinct terms (such as "derivative" used herein), however, may not suffice to meet the written description requirement. This is particularly true when a compound is claimed in purely functional terms. See Univ. of Rochester v. G.D. Searle, 69 USPQ2d 1886 (CAFC 2004) at 1892, stating:

The appearance of mere indistinct words in a specification or a claim, even an original claim, does not necessarily satisfy that requirement. A description of an anti-inflammatory steroid, i.e., a steroid (a generic structural term) described even in terms of its functioning of lessening inflammation of tissues fails to distinguish any steroid from others having the same activity or function. A description of what a material does, rather than of what it is, usually does not suffice.... The disclosure must allow one skilled in the art to visualize or recognize the identity of the subject matter purportedly described. (Emphasis added).

Conversely, a description of a chemical genus will usually comprise a recitation of structural features common to the members of the genus, which features constitute a substantial portion of the genus. See Univ. of Calif. V. Eli Lilly, 43 USPQ 2d 1398, 1406 (Fed. Cir. 1997). This is analogous to enablement of a genus under Section 112, ¶ 1, by showing the enablement of a representative number of species within the genus.

A chemical genus can be adequately described if the disclosure presents a sufficient number of representative species that encompass the genus. *If the genus has substantial variance, the disclosure must describe a sufficient number of species to reflect the variation within that genus*. See MPEP 2163. The MPEP lists factors that can be used to determine if sufficient evidence of possession has been furnished in the

Art Unit: 1612

disclosure of the Application. These include the level of skill and knowledge in the art, partial structure, physical and/or chemical properties, functional characteristics alone or coupled with a known or disclosed correlation between structure and function, and the method of making the claimed invention. Disclosure of any *combination of such identifying characteristics that distinguish the claimed invention from other materials* and would lead one of skill in the art to the conclusion that the applicant was in possession of the claimed species is sufficient. MPEP 2163.

Here, the specification does not provide a reasonably representative disclosure of useful “derivatives” generally, a potentially huge genus inclusive of many different compounds having widely divergent structures and functions. Specifically, the specification discloses only a limited number of species at page 5, line 19 to page 6, line 3, and these are not viewed as being reasonably representative of the genus in its claimed scope because no readily apparent combination of identifying characteristics is provided, other than the disclosure of those specific species as examples of the claimed genus.

### ***2<sup>nd</sup> Paragraph***

Claims 1-8 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The term “derivative” is indefinite because it is unclear how far one can deviate from the parent compound without the “derivative” being so far removed therefrom as to

be a completely different compound. See the related rejection in the "Written description" section supra.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Syudo (EP 1151751) in view of Jehn-Rendu et al. (Us Patent Publication No. US 2003/0012760).

Syudo discloses gel compositions formed by cross linking a polymer with two substances selected from magnesium aluminometasilicate ( $\text{Al}_2\text{O}_3 \bullet \text{MgO} \bullet 2\text{SiO}_2 \bullet x\text{H}_2\text{O}$ ); dried aluminum hydroxide gel ( $\text{Al}_2\text{O}_3 \bullet n\text{H}_2\text{O}$ ); and aluminum chloride. The components are present in the gel composition at concentrations ranging from 0.05-5 parts by weight per 100 parts by weight of the gel (abstract and page 2, lines 29-44). Said composition

Art Unit: 1612

comprises polyacrylic acid, sodium polyacrylate (as gels), water, and 0.01-10 parts by weight per 100 parts by weight of vitamin C or derivative (paragraph [0007]) thereof such as L-ascorbyl magnesium phosphate, which is defined as a salt of the ester of instant claim 6 (instant specification, p.6, line 2) with pHs in the range of 5.5-8.5 ([0010]) when diluted with purified water (page 5, table 1) and further comprising a polyhydric alcohol ([0010]).

It should be noted that the Examiner is interpreting the compound magnesium aluminometasilicate having the formula  $(\text{Al}_2\text{O}_3 \bullet \text{MgO} \bullet 2\text{SiO}_2 \bullet x\text{H}_2\text{O})$  as being a type of magnesium hydroxide-aluminum hydroxide co-precipitate because the prior art teaches aluminum hydroxide gel has the formula of  $(\text{Al}_2\text{O}_3 \bullet n\text{H}_2\text{O})$ , which is present in the magnesium aluminometasilicate compound.

Syudo differs from the instant claims insofar as it does not explicitly disclose an acrylic acid/sodium acrylate copolymer.

Jehn-Rendu et al. disclose cosmetic gels comprising an acrylic acid/sodium acrylate copolymer (p. 2, paragraphs [0038] and [0043]). Said gels do not have the disadvantage of causing friction and blotches on the surface of the skin (p. 1, [0009] and [0011]).

It would have been obvious to have used the acrylic acid/sodium acrylate copolymer in the composition of Syudo motivated by the desire to form a composition that does not cause friction and blotches on the surface of the skin as disclosed by Jehn-Rendu et al.

Art Unit: 1612

The prior art discloses a pH of 5.5-8.5. Thus, the prior art differs from the instant claims insofar as it does not disclose the particular endpoints recited therein, i.e. 6.5-8.5. It is well-settled, however, that even a slight overlap in range establishes a *prima facie* case of obviousness. In re Peterson, 65 USPQ2d 1379, 1382 (Fed. Cir. 2003). Accordingly, it since an overlap plainly exists here, it would have been obvious to have selected values within the overlap, consistent with the reasoning of the Peterson decision.

### ***Conclusion***

No claim is allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to NANNETTE HOLLOMAN whose telephone number is (571) 270-5231. The examiner can normally be reached on Mon-Fri 800am-500pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Frederick Krass can be reached on 571-272-0580. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 1612

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/N. H./  
Examiner, Art Unit 1612

/Frederick Krass/  
Supervisory Patent Examiner, Art Unit 1612